

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

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PORTNER, V

ART UNIT	PAPER NUMBER
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1641

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DATE MAILED:

09/15/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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DETAILED ACTION

Claims 1-28 are pending in the instant Application.

Sequence Letter

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821 (a) (1) and (a) (2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.136. In no case may an applicant extend the period of response beyond the six month statutory period and the response period is the time set in this action. Direct the response to the undersigned. Applicant is requested to return a copy of the attached Notice to Comply with the response.

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-13 are, drawn to isolated nucleic acid molecules, vectors, host cells, and a method of using said host cells to produce a polypeptide, classified in class 536, subclass 23.1.
 - II. Claims 14-16 are, drawn to a method of treating a subject for Enterobacter infection, classified in class 514, subclass 44.
 - III. Claim 24 is, drawn to a method of detecting a Enterobacter nucleic acid, classified in class 935, subclass 78 .

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- IV. Claims 17-20 are, drawn to various polypeptides, classified in class 424, subclass 234.1.
- V. Claims 21-23 are, drawn to methods of treating a subject for Enterobacter infection, classified in class 530, subclass 387.1.
- VI. Claims 25-28 are, drawn to a computer readable medium, a computer based system and a method of identifying commercially important nucleic acids used a database , classified in class 395, subclass 200.41+.

2. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

3. The inventions are distinct, each from the other because of the following reasons:

4. Inventions I and II or III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product, specifically the isolated nucleic acid molecules, vectors and host cells may be used in methods of making a recombinantly produced polypeptide, wherein the purified nucleic acids may be in turn be useful in methods of treating, generating a vaccine or detecting the corresponding nucleic acid as indicative of infection .

5. The invention of group I is distinct from the invention of group IV because it is drawn to materially different compositions that require non-coextensive areas of search and consideration.

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For example, the proteins of the invention of Group IV may be isolated from natural sources and are not necessarily defined by the DNAs that encode them, wherein polypeptides and nucleic acids represent independent and distinct inventions based on differing structures, functions and effects associated with each of the distinct molecules.

6. Inventions IV and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product, specifically in methods of detecting antibodies, in methods of purifying antibodies, as well as in methods of generating a vaccine, and producing molecule image polymers.

7. Inventions I-V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the claimed computer readable medium and computer based system does not use isolated nucleic acids or polypeptides in its mode of operation but functions by differs modes of operation which results in differing functions and effects.

8. Claims 17-20 or 21-23 are drawn to a plurality of disclosed patentably distinct products comprising materially different proteins. Should the inventions of Group IV or V be elected, Applicant would be required under 35 U.S.C. 121 to elect a single disclosed product, even though this requirement is traversed. The separate proteins bear no structural or biochemical property in

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common and therefore each particular protein product claimed and would require a separate area of search and consideration tailored to the particular product under consideration.

9. Claims 1-13 and 14-16 and 23 are drawn to a plurality of disclosed patentably distinct inventions comprising materially different nucleic acid molecules which encode polypeptides. Should the inventions of Group I or II or III be elected, Applicant would be required under 35 U.S.C. 121 to elect a single disclosed product, even though this requirement is traversed. The separate nucleic acid molecules bear no structural or biochemical property in common and therefore each particular nucleic acid product claimed and would require a separate area of search and consideration tailored to the particular product under consideration.

10. Applicant is required to select **no more than ten of the individual (EST) polynucleotide sequences** for examination. The search of no more than ten selected sequences may include the complements of the selected sequences and, where appropriate, may include sequences within the selected sequences (e.g. oligomeric probes and/or primers), **Claims which recite of an isolated polynucleotide sequence encoded by a polypeptide SEQ ID NO XXX or encodes a polypeptide would afford Applicant the opportunity to elect a single nucleotide sequence as patentability would rest upon the structure and function of the polypeptide as well as the nucleic acid sequence which encodes it.** Therefore, an isolated nucleic acid molecule of SEQ ID NO XXX which encodes a polypeptide, would define patentably distinct sequences not covered by the election/restriction rules for expressed sequence tags (EST); claims which recite multiple amino acid sequences which are encoded by an isolated nucleic acid molecule would be

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considered by the examiner as an improper Markush group as each polypeptide would evidence patentably distinct structural and functional characteristics and the mere association of the molecules because of origin does not provide for the establishment of a proper Markush group claim. **Election of a single nucleic acid sequence which in codes a polypeptide would be required if the claims were to recite claim limitations which would not qualify the claim as an EST claim.**

In light of the above, Applicant is requested to elect an invention in accordance with the OG notice or in accordance with MPEP rules for restriction.

11. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their different classification, recognized divergent subject matter, and because the searches required for the separate groups of inventions are non-coextensive, restriction for examination purposes as indicated is proper.

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginny Portner whose telephone number is (703)308-7543. The examiner

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can normally be reached on Monday through Friday from 7:30 AM to 5:00 PM except for the first Friday of each two week period.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027. The fax phone number for this group is (703) 308-4242.

The Group and/or Art Unit location of your application in the PTO will be changing February 7, 1998. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art 1641.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Vgp

May 19, 1999

9/13/99
VGP



CHRISTOPHER L. CHIN
PRIMARY EXAMINER
GROUP 1641